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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,707	07/12/2001	Jeff N. Maggioncalda	02821.P001XC	4572

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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/904,707

Applicant(s)

MAGGIONCALDA ET AL.

Examin r

Thomas A. Dixon

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-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-78 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of: .
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendments / Arguments

1. Claims 14-15 have been cancelled, claims 34-78 added.
2. The rejections of the previous office action are withdrawn, applicant's arguments are moot.
3. The new title is acceptable.
4. Some of applicant's amendments introduce indefinite language into the claims and are rejected under 35 USC § 112 below.
5. Reconsideration of the claims has revealed 35 USC § 101 issues below.

Priority

6. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).

In this case, the mere statement of incorporation by reference in the parent 09/495,982 is not seen too be sufficient. In the Figures, figures 9-19 of the instant application are present in '217 and '044 patents, but are not presented in the '982 parent application. Further, the detailed descriptions of the '217 and '044 patents are

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not incorporated into the parent in such a way as to enable one of ordinary skill to determine how the '982 parent and the incorporated matter are meaningfully interwoven. It is therefore seen that the present application is a Continuation in Part of 09/495,982 application (which is a CIP of the 08/982,042 application, now Patent 6,012,397).

7. This application repeats a substantial portion of prior Application No. 09/495,982, filed 01 January 2000, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to MPEM 201.11.

Oath/Declaration

8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Applicant is specifically directed to the signature of Ken Fine (black ink) and date (blue ink) in what appears to be a different hand.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-78 are rejected under the judicially created doctrine of double patenting over claims 1-41 of U. S. Patent No. 5,918,217 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter of a user interface for a financial advisory system.

Claim Rejections - 35 USC § 112 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 3, 7, 20, 23-24, 32-33, 34, 43, 52 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the terms "feasible set of risk," "feasible input decisions" and "constrained to be feasible" are indefinite.

Claim Rejections - 35 USC § 112 6th paragraph

11. Claims 26-29, 78 are rejected under 35 U.S.C. 112, sixth paragraph.

Although Applicant(s) use "means/step for" in the claim(s) (e.g. claim 26), it is the Examiner's position that the "means for" phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to

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either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th Paragraph*.¹

Failure by Applicant(s) to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12 Claims 1, 3-10, 16-17, 32-33, 43-78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Specifically, the claims do not meet the Court's definition of a “statutory process.” There is no treatment of materials such that subject matter is transformed and reduced to a different state. The claims contain no apparatus of any sort and are therefore, not in the technological arts and non-statutory.

Election/Restrictions

13. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 1-10, 19, 20-25, 27, 29, 32-33 drawn to drawn to displaying inputs/outputs and refreshing the display related to retirement age.
- II. Claims 11-13, drawn to concurrently displaying, input decisions regarding level of risk, output values regarding risk and updating the output values.
- III. Claims 16-17, 30-31 drawn to determining a recommended allocation of financial products based on risk.
- IV. Claims 18, 26, 28 drawn to displaying inputs/outputs and refreshing the display related to financial goals.
- V. Claims 34-42, drawn to receiving a retirement income goal.
- VI. Claims 43-51, drawn to tradeoffs in time horizon related to financial goals.
- VII. Claims 52-60, drawn to exploring tradeoffs of time, savings and risk.
- VIII. Claims 61-69, drawn to recommending an allocation among mutual funds.
- IX. Claims 70-78, drawn to identifying relationships between financial products.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

Group II has separate utility such as a risk analysis tool for retirement planning as in group I or IV. See MPEP § 806.05(d).

¹ Federal Register Vol. 65, No 120, June 21, 2000.

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Groups III and VIII have separate utility such as asset allocation tools. See MPEP § 806.05(d).

Group V has separate utility such as a retirement income planning tool. See MPEP § 806.05(d).

Groups VI, VII have separate utility such as “what if” financial planning tools. See MPEP § 806.05(d).

Group IX has separate utility such as a general purpose financial planning tool. See MPEP § 806.05(d).

Multiplicity

14. Claims 1-78 are rejected based on undue multiplicity under 37 CFR 1.75(b). According to MPEP 2173.05 (n), an unreasonable number of claims, that is unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis for a rejection on the ground of multiplicity. It is noted that Applicant's claims are repetitious and multiplied with a net result of a cloud of confusion.

See *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (1963) and *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969). Applicant will be requested to select thirty (35) claims for examination.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read "Thomas A. Dixon", with a stylized flourish at the end.

Thomas A. Dixon
Primary Examiner
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April 15, 2003